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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/068,253 | 06/09/1998 | TAKESADA SHIMURA | 146.1286 | 2129 |
| 20311 | 7590 | 11/26/2003 | EXAMINER | |
| MUSERLIAN AND LUCAS AND MERCANTI, LLP | | | MOHAMED, ABDEL A | |
| 475 PARK AVENUE SOUTH | | | ART UNIT | PAPER NUMBER |
| NEW YORK, NY 10016 | | | 1653 | |

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/068,253

Applicant(s)

SHIMURA ET AL.

Examiner

Abdel A. Mohamed

Art Unit

1653

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 20 October 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: _____.
3. ☒ Applicant's reply has overcome the following rejection(s): The rejection under 35 U.S.C. 112, second paragraph.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 2-5, 8-11, 14 and 15.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.


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SUPERVISORY PATENT EXAMINER
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Continuation of 5. does NOT place the application in condition for allowance because: The objection under 35 U.S.C. 132 as introducing new matter in the disclosure and the rejection of claims 2-5, 8-9 and 14-15 under 35 U.S.C. 112, first paragraph as containing new matter are maintained for the same reasons discussed in the previous Office action (Paper No. 40, mailed 4/21/03). Applicant's arguments that the use of the term "polyoxyethylene-polyoxypropylene" as currently used in the specification is proper and chemically correct. The propylene glycol used for the production of the polyoxyethylene-polyoxypropylene glycol is proper terminology and is clearly supported by the specification as filed. Thus, the specification now defines the polyoxyethylene-polyoxypropylene glycol in a proper manner. Therefore, the claims do comply with 35 U.S.C. 112, first paragraph is unpersuasive. Contrary to Applicant's arguments, Applicant has not shown where such subject matter has support from the original disclosure; except by stating that "The propylene glycol used for the production of the polyoxyethylene-polyoxypropylene glycol is proper terminology and is clearly supported by the specification as filed". Thus, absent of showing support in the originally filed disclosure for "polyoxyethylene-polyoxypropylene" as currently amended in the specification and claims; deletion of "glycol" would broaden the classes of polyoxyethylene-polyoxypropylene or polypropylene because the originally filed disclosure is narrower in scope since they disclose explicitly specific classes of polyoxyethylene-polyoxypropylene or propylene having glycol. Therefore, the objection of the specification and the rejection of the claims as introducing new matter are maintained for the same reasons discussed in the previous Office action. It is noted that Applicant has provided a clean copy of the amendment of the claims. However, on page 2 of the amendment filed on 10/1/03, claim 5 appears to be incomplete by stating "The cartilage and bone morphogenic repairing composition as in claim". Thus, the claim ends without full stop and the sentence appears to be incomplete. Appropriate correction is required.